

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SETSUO SHOUJI and MASAHIKO TSUNEMI

Appeal No. 2003-1302
Application 09/035,478

ON BRIEF

Before FRANKFORT, STAAB, and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9 through 13, 25 and 26, which are all of the claims remaining in this application. Claims 1 through 8 and 14 through 24 have been canceled.

Appellants' invention is directed to a split sleeve preform formable into a split sleeve adapter for fitting rod members,

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such as optical fibers, therein from respective ends to thereby effect abutment of tip surfaces of the rod members against each other. Independent claims 9, 25 and 26 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellants' brief.

The sole prior art reference of record relied upon by the examiner is:

Kooji (Japanese) ¹	04-006507	Jan. 10, 1992
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Claims 9 through 13, 25 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kooji.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we refer to the examiner's answer (Paper No. 25, mailed November 18, 2002) for a complete exposition of the examiner's position

¹Our understanding of this foreign language document is based on a translation prepared for the U.S. Patent and Trademark Office. For appellants' convenience, a copy of that translation is attached to this decision.

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and to appellants' brief (Paper No. 24, filed August 6, 2002) and reply brief (Paper No. 26, filed January 13, 2003) for the arguments thereagainst.

OPINION

Having carefully reviewed the anticipation issues raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejection of the appealed claims under 35 U.S.C. § 102(b) will be sustained with regard to all claims on appeal. Our reasoning in support of this determination follows.

In rejecting claims 9 through 13, 25 and 26 under 35 U.S.C. § 102(b) the examiner specifically directs us to Figure 3 of Kooji, urging (answer, page 3) that this figure shows a split sleeve component of the type envisioned by appellants comprising a tubular body having a pair of grooves (3) extending along the longitudinal axis thereof between first and second terminal ends and penetrating through the inner and outer peripheral surfaces of the tubular body, first and second annular portions (14) disposed at and extending respectively from the first and second

terminal ends of the tubular body, and an intermediate annular portion (4) disposed between the inner ends of the grooves (3). The examiner contends that appellants' "split sleeve preform formable into a split sleeve" as recited in the claims on appeal is structurally indistinguishable from the split sleeve component seen in Figure 3 of Kooji, because the component in Figure 3 of Kooji can be formed (i.e., is formable) into a split sleeve (e.g., similar to that in Fig. 1 of Kooji) by merely severing the end portions (14) adjacent the outer ends of the grooves (3).

Appellants' arguments in the brief and reply brief with regard to independent claims 9, 25 and 26 focus on the fact that the component (E) seen in Figure 3 of Kooji is itself a split sleeve adapter used for fitting rod members, such as optical fibers, therein from respective ends to thereby effect abutment of tip surfaces of the rod members against each other, and is not specifically described as being a "preform" that is subsequently formable into a split sleeve, as required by the appealed claims. More particularly, appellants' contend (e.g., brief, page 11, and reply brief, page 5) that the annular portions (14) disposed at respective ones of the terminal ends of the tubular body in Kooji Figure 3 "are not severable (i.e., are not intended to be

severed), but are rather permanent portions of the split sleeve” (emphasis in original).

An anticipation under 35 U.S.C. 102(b) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element or limitation of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed Cir 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, we observe that the law of anticipation does not require that the reference teach what the appellant has disclosed but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

While it is true that there is nothing in the Kooji reference which expressly indicates that the split sleeve component seen in Figure 3 thereof is a “preform” that is intended to be subsequently modified by cutting through the annular portions (14) thereof, we are in complete agreement with

the examiner that the component of Kooji Figure 3 is structurally identical to that defined in the claims before us on appeal and is inherently capable of being used as a "preform" in the manner required in the claims on appeal (e.g., to form a split sleeve adapter similar to that seen in Figure 1 of Kooji).

As was made clear in In re Schreiber, 44 USPQ2d at 1431, by choosing to define an element functionally as in appellants' claims 9, 25 and 26 on appeal, appellants assume a risk, that risk being that where the U.S. Patent and Trademark Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require applicants to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon. In the present case, appellants have provided no evidence to prove that the split sleeve component seen in Figure 3 of Kooji lacks the functionally defined limitations set forth in claims 9, 25 and 26 on appeal. We therefore agree with the examiner that the differences in the intended use of appellants' split sleeve preform and the split

sleeve component of Figure 3 of Kooji do not patentably distinguish the claimed "split sleeve preform" from the split sleeve component seen in Kooji.

In contrast to appellants' position, we do not see that a "preform," in its broadest sense, would be understood by one of ordinary skill in the art as being a term applied only to a component that is specifically designed and constructed as an intermediate product having no other use except for being subsequently further modified or altered to be another component. We view the term "preform" as being applicable to a structure from which a final product is or may be formed, whether or not that initial structure itself has or was intended in the first instance to have another use.

For the above reasons, we will sustain the examiner's rejection of claims 9 through 13, 25 and 26 under 35 U.S.C. § 102(b) as being anticipated by Kooji (Fig. 3). The decision of the examiner is, accordingly, affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR §
1.136(a).

AFFIRMED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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JOHN P. McQUADE)	
Administrative Patent Judge)	

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